

REMARKS

In the application claims 1-24, 29, and 31 remain pending. Claims 25-28, 30, and 32-40 have been canceled without prejudice.

Claim 29 has been amended to include the subject matter set forth in previously pending claim 36 including the subject matter set forth in the intervening claims. In accordance with 37 CFR § 1.116(b)(1) entry into the record of the amendment to claim 29 is required. Such action is respectfully requested.

As requested in the Office Action, the Abstract has been amended to remove the use of the words “the invention.”

The pending claims presently stand rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

Pending claims 1-24 presently stand rejected as being anticipated by or rendered obvious by Goldstein (US 5,410,326) while pending claims 29 and 31 stand rejected as being rendered obvious by Goldstein in combination with Evans (US 4,825,200).

In response, it is respectfully submitted that a rejection under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 can be maintained only when a single reference or combination of references, respectively, disclose the invention claimed “as a whole,” i.e., each and every element considering each and every word.

As concerns the rejection of claims 1-24, it is respectfully submitted that Goldstein fails to disclose, teach, or suggest at least the claimed “controlling circuit [which] allows transmission of the signal to the target external to the remote control in response to activation of the button only when the means for indicating is activated” or at

least the claimed “allowing the remote control to transmit a signal in response to activation of the button only when the means for indicating is activated.”

The Office Action has asserted that these claim elements are disclosed within Goldstein at Col. 4, lines 11-26, Col. 11, lines 15-68, or Col. 13, line 58-Col. 14, line 55).

Col. 4, lines 11-26 of Goldstein discloses that a command may be sent to a telephone interface in response to activation of a command key to establish a phone connection with a service provider. Nowhere, however, does Col. 4, lines 11-26 disclose, teach, or suggest that the command is allowed to be sent to the telephone interface in response to activation of the command key only when some means for indicating that is associated with that key is activated. Rather, the command key used to establish a phone connection of Goldstein is *allowed to transmit a command at all times* and will therefore *always* be capable of transmitting a command to the telephone interface when it is activated. Accordingly, it is submitted that the disclosure at Col. 4, lines 11-26 cannot be said to anticipate or render obvious the invention claimed when the claims are considered “as a whole.”

Col. 11, lines 15-68 of Goldstein discloses that a mail icon may be activated to transmit a command to transfer mail messages to the remote control and that a menu icon may be activated to transmit a command to the telephone interface to establish a phone connection. Nowhere, however, does Col. 11, lines 15-68 disclose, teach, or suggest that these commands are allowed to be sent in response to activation of the corresponding icon only when some means for indicating that is associated with that icon is activated. Rather, these icons of Goldstein are *allowed to transmit commands at all times* and will therefore *always* be capable of transmitting a command when activated. Accordingly, it

is submitted that the disclosure at Col. 11, lines 15-68 cannot be said to anticipate or render obvious the invention claimed when the claims are considered “as a whole.”

Col. 13, line 58-Col. 14, line 55 of Goldstein discloses that an advertisement may be displayed on a television to signal to a user that a command key may be activated to transmit a command to retrieve data. Nowhere, however, does Col. 13, line 58-Col. 14, line 55 disclose, teach, or suggest that the command to retrieve data is allowed to be sent in response to activation of the key only when some means for indicating that is associated with that key is activated. Rather, this key of Goldstein is *allowed to transmit commands at all times* and will therefore *always* be capable of transmitting a command in an attempt to retrieve data every time it is activated. Accordingly, it is submitted that the disclosure at Col. 11, lines 15-68 cannot be said to anticipate or render obvious the invention claimed when the claims are considered “as a whole.”

In sum, it is respectfully submitted that Goldstein fails to expressly disclose all of the elements set forth in the claims. It is additionally submitted that Goldstein fails to “inherently” disclose all of the elements set forth in the claims. In this regard, to be “inherently” described in a reference, the reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991). Thus, since Goldstein fails to have either the express or inherent disclosure required to support a rejection under 35 U.S.C. §§ 102 or 103, it is submitted that the rejection of claims 1-24 must be withdrawn.

As concerns the rejection of claims 29 and 31, it is respectfully submitted that nowhere does Evans disclose, teach, or suggest an instruction being sent to a remote control that includes a command for restricting operation of the remote control such that only the at least one button indicated by the instruction may be operated and wherein the command for restricting operation is activated for a preset time period as is claimed. While the Office Action has asserted that Evans discloses this claimed element and, as such, suggests modifying Goldstein to arrive at the invention claimed, it is respectfully noted that the “wait delay” disclosed within Evans has absolutely no relevance to that which is claimed. In particular, the “wait delay” in Evans does not restrict operation of any keys of the Evans remote control for any preset period of time. Rather, the “wait delay” of Evans is nothing more than an amount of time that can be set when a macro command sequence is programmed on the remote control which is used to cause a delay between the *automatic* transmission of consecutive commands in the programmed macro command sequence. Furthermore, the setting of a timer as disclosed within Evans to cause a command sequence to be executed at a set time also has no relevance to restricting operation of keys of a remote control keypad for a preset period of time as claimed. Specifically, in Evans, the user may respond to the prompt to set the timer *at any time*, i.e., the antithesis of a preset time. Thus, since nothing from Evans can be said to disclose that which is missing from Goldstein and, therefore, nothing from Evans can suggest modifying Goldstein to arrive at the invention claimed, it is respectfully submitted that the rejection under 35 U.S.C. § 103 of claims 29 and 31 must be withdrawn.

Conclusion

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully Submitted

Date: April 12, 2006

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